



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

5.12.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,633	05/22/2000	William B. Johnson		1491

7590 02/27/2004

JAMES V. HARMON  
Pillsbury CENTER, sUITE 2000  
220 SOUTH Sixth Street  
Minneapolis, MN 55402

EXAMINER
----------

LEVY, NEIL S

ART UNIT	PAPER NUMBER
----------	--------------

1616

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/575,633

Applicant(s)

JOHNSON, WILLIAM B.

Examiner

Neil Levy

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12/16/83
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 26-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 26-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 26-Amphoteric was misspelled. A comma is needed after borate-claim 33.

The surfactants are not specific, contrary to applicant's statement, except for the ethoxylated nonylphenol-The group includes toxic surfactants, functionable as insecticides-applicant presumably intends to exclude chemicals and, perhaps, virus, bacterial and fungal entomopathogenic insecticides, perhaps as either commonly recognized or as so identified by EPA. However, the language does not exclude the surfactants, and we do not see support, nor can applicant change common meaning in the process of being his own lexicographer. At claims 27, 28 please explain an—aqueous ~~ve~~ <sup>vs</sup> non aqueous.

It seems that applicant is using toxicity to mean acute toxicity. Also, the public does not know the distinction between risk, hazard and toxicity; otherwise we would not have so many poisonings by contact or ingestion of labeled chemicals. See CRC definitions and descriptions. Applicants' solution is to identify the inventive surfactants applicant has stated to have discovered. The concept of suffocation is not novel. Applicants claim 33 is toxic.

Claims 26-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which

Art Unit: 1616

was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant's method requires direct spraying in such a manner as to coat the entire insect in a film—it is not at all clear where support lies for the means to target hold and coat the insect. As examiner reads the specification, it is only evident that spraying at a distance, as opposed to, for presumptions sake, holding, rolling and covering an insect with the sprayed surfactant in some liquid. If the terminology is simply an explanation of what happens, we accept it.

If the liquid is non-aqueous (an aqueous) this is contrary to applicants' statement of what the invention is (p.4 of remarks, water-soluble ~) so is claim 33 a contrary claim, incorporating unspecified amounts and concentrations of toxicants.

The art rejections are maintained, as, shown above, applicant has not limited to the inventive surfactants, the toxic chemicals can still be present, and the solution can be aqueous or an aqueous.

Claims 26-28, 32, are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over MORITA-5110594.

Here we find natural components, the instant non-toxic, environmentally compatible components, (food contact material-col.1 (2), Table and col.2) as insecticides, with surfactants (col.2, last paragraph) useful with other insecticides, preservatives, bactericides, etc, (col.3, top) not harmful to animals and humans, and providing pleasant aroma. The compositions can be filled into a spray vessel for spraying (col.4, embodiment 5). Solvents are used for the sell oil, such as oils,

Art Unit: 1616

triglycerides, and liquid carriers can also include water. Although the "sprayed for use" comment is all that denotes the method, one can immediately envision the Morita composition application to a verminous insect pest in one's presence, such as a buzzing fly or mosquitoes, with use of the spray directed at the insect, and the instantly claimed enveloping blocking spiracles, and death following as a matter of course. Note that the sell flower extract itself contains surfactants limonene, terpinenes and terpens, linalool, nerylacetate for instance (table, col.1, 2). Finally, note that the stuff is applied to dogs, with impunity. The means of death dealing was not subject to control by artisan, but neither is there any difference between what the inventive applicator does and Morita, in the spray mode.

Claims 26-28, 31-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Mueninghoff et al 6068849.

Application of insecticidal compositions to insects is disclosed (col.2, lines 22-26) using as insecticide, surfactants as pesticide concentrate and emulsifier (col.2, line 32-line 2, col.3) functioning to spread across the substrate. Therefore, when substrate includes insect, it spreads across the insect and would therefore do as the instant claim requires. Additional surfactant may be desirable (col.3, paragraph.2). See claim 15-an aqueous solution of surfactant mix with insecticide is applied to a plant pest. Calcium sources are envisioned-example 2, line 30, col.7. The biocides do not interfere with the action of the surfactants. The utilization of these compositions is in tank mixes (col. 1, 23-49) thus, sprayed, and providing a required surfactant, but substantially devoid of

Art Unit: 1616

toxicants at non-target species toxic levels. See claim 13- as little as .1% of 0.1% bio-active component is present.

Claims 26, 27, 31, 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Neal et al '94.

Insects were sprayed (p.1601, col.1) with sucrose esters (col.2); surfactants-, they died. Safer soap, and combinations of surfactants, also killed insects (tables 4 and 5). In fact, the insects were subjected to the same method steps as the instant-they died, no matter whether Neal saw them suffocate or not. The same stuff, applied to the same pest in the same manner meets the instant method, regardless of recognition of mechanism of the effect.

Claims 26, 29, 32, 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Alleman-1591006.

Non-toxic mineral oil and surfactant in water (p.1, lines 50-52) further diluted (p.2, lines 80-90) and applied to insects, acting as a detergent (lines 94, 95), applied as spray (claim 9).

Claims 26-28, 31, 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Hagarty 6028117.

See abstract. The instant concept and lines 52-67, col.1, lines 14-31, col.2, the surfactant; nonyl phenol ethoxylate, applied by spraying the insect (col.3, top).

Claims 26-30, 33 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lindstaedt-2032246.

Art Unit: 1616

Suffocation of insects is taught by spraying (p.1, lines 1-19) environmentally safe oil in water emulsion, with add borax and casein thickener (p.2, lines 52-75).

Claims 26-28, 32 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over ~~K~~Night-1937969.

Here, too non-toxic surfactants, as emulsions, are lethal to insects. When applied (clearly with in the purview of the horticulturist to spray) (page 1, lines 60-70). An aqueous liquids are also used-mineral oil (page 1, lines 45-60).

Claims 34, 35 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1616

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is 571-272-0619.

The examiner can normally be reached on Tuesday through Friday from 7a.m to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Levy/tgd

February 20, 2004



NEIL S. LEVY  
PRIMARY EXAMINER